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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/692,409 | 10/23/2003 | William Kress Bodin | AUS920030249US1 | 8497 |
| 34533 | 7590 | 04/27/2005 | EXAMINER | |
| IBM CORP (BLF) c/o BIGGERS & OHANIAN, LLP 504 LAVACA STREET, SUITE 970 AUSTIN, TX 78701-2856 | | | ASSOUAD, PATRICK J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2857 | |

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,409

Applicant(s)

BODIN ET AL.

Examiner

Patrick J. Assouad

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2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 16-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. In light of the numerous co-pending patent applications filed by Applicant, the Examiner respectfully reminds Applicant of his duty to disclose under 37 CFR 1.56, 1.97, and 1.98. If any co-pending patent applications are not listed in the attached PTO-892, they have not been considered.
2. The information disclosure statement filed 3/15/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because one of the references is not relevant to patentability of the instant claimed invention. A typographical error may exist because the cited PGPub application of Hess et al. is related to perfume dispensing. It has been placed in the application file, but the information referred to therein (Hess et al. only) has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Objections

3. Claim 16-20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16-20 recite the limitation "the computer program product". There is insufficient antecedent basis for this limitation in the claims. These claims should depend from independent claim 15 which is a "computer program product" claim.

Allowable Subject Matter

4. Claims 1-20 are allowable over the prior art of record. The instant claimed invention is a "method [or system or computer program product] for evaluating a test action for a user". For purposes of 35 USC 112, 6d, and the required means-plus-function claim interpretation of claims 8-14, note that Fig. 12 -- which is described beginning on pg. 72 of the instant Specification -- is the exemplary schematic drawing for the instant claimed invention.

5. The closest prior art of record is McKennan et al. (US 2004/0176991 A1), most notably Fig. 3 (reproduced below), and Maes et al. (US 2002/0135618 A1), most notably, Fig. 3 (also reproduced below).

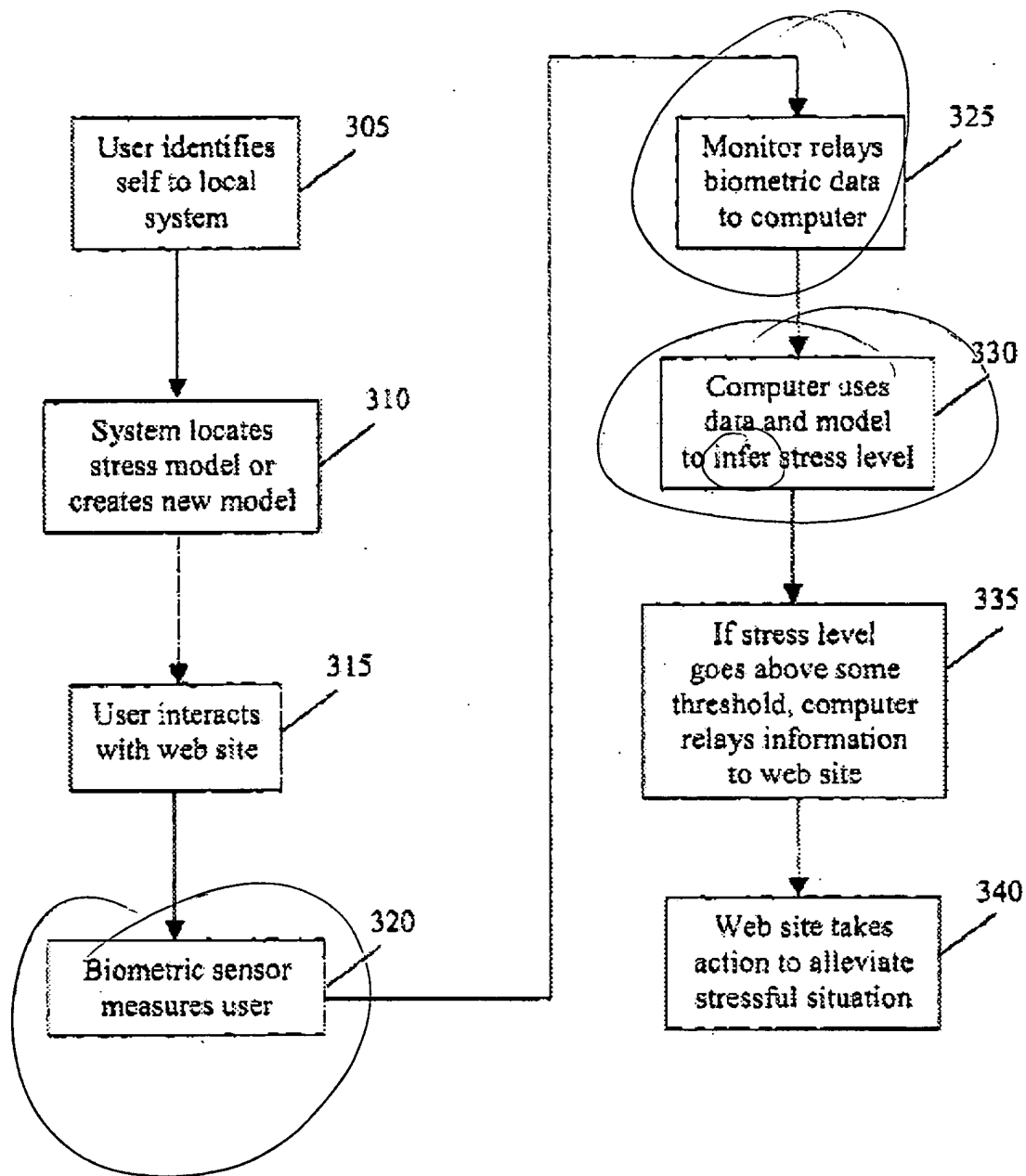


FIG. 3

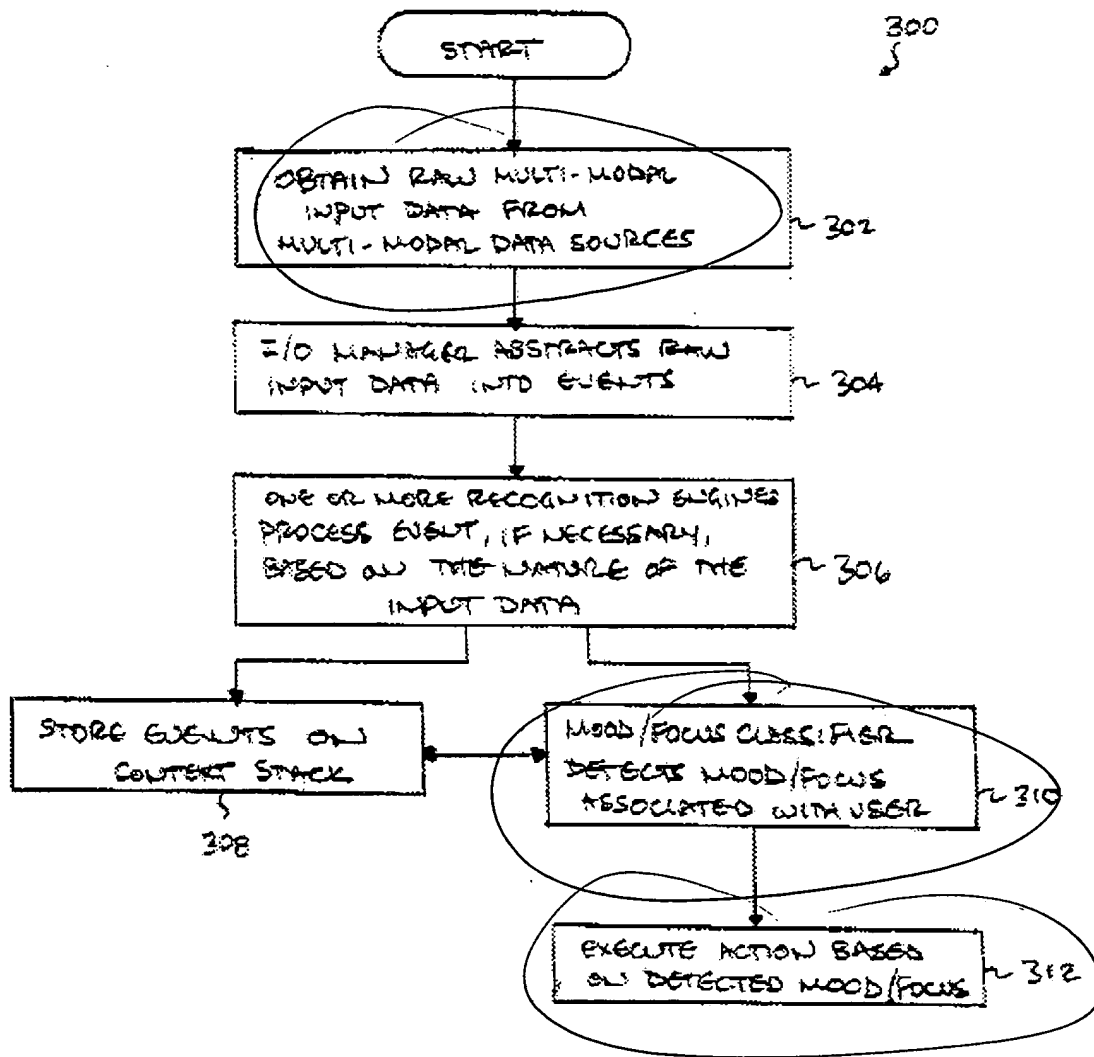


FIG. 3

6. However, the prior art of record does not suggest or disclose the claimed combination of method steps or system elements or computer program product

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elements, most notably the claimed "selecting a test action in dependence upon the user metric vector [which is dependent upon a plurality of disparate user metrics within a network]; executing the test action within the network; and determining a user reaction."

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892.

8. This application is in condition for allowance except for the following formal matters:

See above.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Assouad whose telephone number is 571-272-2210. The examiner can normally be reached on Tuesday-Friday, 6:30am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick J Assouad
Primary Examiner
Art Unit 2857

pja